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PTO/SB/21 (09-04)

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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	10/750,138-Conf. #9762
	Filing Date	December 31, 2003
	First Named Inventor	David Gschneidner
	Art Unit	1621
	Examiner Name	D. D. Carr
Total Number of Pages in This Submission	Attorney Docket Number	01946/100G527-US2

ENCLOSURES (Check all that apply)

<input checked="" type="checkbox"/> Fee Transmittal Form <input checked="" type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input checked="" type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Return Receipt Postcard
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm Name	DARBY & DARBY P.C.		
Signature			
Printed name	Jason C. Churney		
Date	March 24, 2006	Reg. No.	54,781



FEE TRANSMITTAL For FY 2006		Complete if Known	
		Application Number	10/750,138-Conf. #9762
<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27		Filing Date	December 31, 2003
TOTAL AMOUNT OF PAYMENT (\$) 130.00		First Named Inventor	David Gschneider
		Examiner Name	D. D. Carr
		Art Unit	1621
		Attorney Docket No.	01946/100G527-US2

METHOD OF PAYMENT (check all that apply)

☒ Check ☐ Credit Card ☐ Money Order ☐ None ☐ Other (please identify): _____

☐ Deposit Account Deposit Account Number: 04-0100 Deposit Account Name: Darby & Darby P.C.

For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)

☐ Charge fee(s) indicated below ☐ Charge fee(s) indicated below, **except for the filing fee**

☒ Charge any additional fee(s) or underpayment of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments

FEE CALCULATION (All the fees below are due upon filing or may be subject to a surcharge.)

1. BASIC FILING, SEARCH, AND EXAMINATION FEES

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 (including Reissues)	50	25
Each independent claim over 3 (including Reissues)	200	100
Multiple dependent claims	360	180

Total Claims **Extra Claims** **Fee (\$)** **Fee Paid (\$)** **Multiple Dependent Claims**

29 - 31 = _____ x _____ = _____ **Fee (\$)** **Fee Paid (\$)**

HP = highest number of total claims paid for, if greater than 20.

Indep. Claims **Extra Claims** **Fee (\$)** **Fee Paid (\$)**

1 - 6 = _____ x _____ = _____

HP = highest number of independent claims paid for, if greater than 3.

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets	Extra Sheets	Number of each additional 50 or fraction thereof	Fee (\$)	Fee Paid (\$)
_____	_____	_____ / 50 _____ (round up to a whole number) x _____ = _____		

4. OTHER FEE(S)

	Fees Paid (\$)
Non-English Specification, \$130 fee (no small entity discount)	
Other (e.g., late filing surcharge): <u>1464</u> Petitions to the Director to review restriction requirement	130.00

SUBMITTED BY			
Signature		Registration No. (Attorney/Agent)	54,781
Name (Print/Type)	Jason C. Churney	Telephone	(212) 527-7700
		Date	March 24, 2006



Application No. (if known): 10/750,138

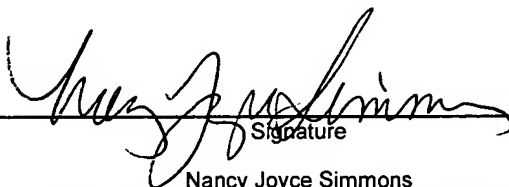
Attorney Docket No.: 01946/100G527-US2

Certificate of Express Mailing Under 37 CFR 1.10

I hereby certify that this correspondence is being deposited with the United States Postal Service as Express Mail, Airbill No. **EV 762808180 US** in an envelope addressed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

on March 24, 2006
Date


Signature

Nancy Joyce Simmons

Typed or printed name of person signing Certificate

Registration Number, if applicable

212-527-7700
Telephone Number

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Transmittal (1 page)
Fee Transmittal Form (1 page)
Petition Under 37 CFR 1.144 (3 pages)
Check no. 11563 in the amount of \$130.00
Return Receipt Postcard



Docket No.: 01946/100G527-US2
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
David Gscheidner et al.

Application No.: 10/750,138

Confirmation No.: 9762

Filed: December 31, 2003

Art Unit: 1621

For: COMPOUNDS AND COMPOSITIONS FOR
DELIVERING ACTIVE AGENTS

Examiner: D. D. Carr

PETITION UNDER 37 CFR §1.144

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants respectfully petition the Director to review the restriction requirement issued in the June 29, 2005 Office Action, and rejoin claims 2-12 and 15-31. The required fee of \$130 for this petition is submitted herewith. The Commissioner is authorized to charge any additional fees due with this submission to Deposit Account No. 04-0100.

Pertinent Facts of the Case

1) On June 29, 2005 the Examiner issued a Restriction Requirement, designating two groups. The first group contained claim 1, which was drawn to eleven compounds. The second group contained claims 2-29, and was drawn to a composition, dosage unit form, and method of using the composition. All of the claims of group II depend from claim 1.

2) On August 4, 2005 Applicants filed an Amendment removing ten of the eleven compounds from claim 1. Applicants also traversed the restriction requirement, arguing that the entire set of claims could be examined without serious burden on the Examiner under MPEP § 803.

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3) In a September 13, 2005 Office Action, the Examiner refused to withdraw the restriction requirement and made it final. Claims 2-31 were deemed withdrawn as drawn to a non-elected invention.

4) In a November 17, 2005 Amendment, claims 13 and 14 were canceled. Applicants also requested that the remaining claims (claims 2-12 and 15-31) be rejoined pursuant to M.P.E.P. § 821.04(a), since these claims depend from claim 1.

5) In a February 24, 2006 Office Action, claim 1 was allowed and the Examiner requested cancellation of the non-elected claims. The Examiner stated that "[a] withdrawn claim that does not [sic: is not] commensurate in scope with the allowable claim will not be rejoined."

Argument

Applicants respectfully submit that the Examiner has improperly refused rejoinder of claims 2-12 and 15-31 on the basis that these claims are not "commensurate in scope." MPEP § 821.04 (a) states:

When all claims to the nonelected invention(s) depend from or otherwise require all the limitations of an allowable claim, applicant **must** be advised that claims drawn to the nonelected invention have been rejoined and the restriction requirement has been withdrawn.

MPEP § 821.04(a) does not mention whether the nonelected claims are "commensurate in scope". This section does, however, require that claims drawn to nonelected inventions be rejoined if they depend from or otherwise require all the limitations of an allowable claim (claim 1). This is the case here.

Summary

In view of the above, Applicants respectfully request rejoinder of claims 2-12 and 15-31.

Dated: March 24, 2006

Respectfully submitted,

By 

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